

REMARKS

The present application was filed on January 12, 2001, with claims 1-32.

Claims 1, 3, 15, 16, 22-24, 26 and 29-32 are rejected under 35 U.S.C. §102(b) as being unpatentable over an article by Thorpe et al. entitled "The All-Digital Camcorder - The Arrival of Electronic Cinematography" (hereinafter "Thorpe").

Claims 1, 3-6, 12, 13, 15-20, 22-24 and 26-32 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,006,039 to Steinberg et al. (hereinafter "Steinberg").

Claims 2, 14 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Steinberg in view of U.S. Patent No. 5,008,739 to D'Luna et al. (hereinafter "D'Luna").

Claims 7-11 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Steinberg in view of Thorpe.

In this response, Applicant amends claims 1, 6, 9, 12-15, 21, 27, 28 and 32, and cancels claims 5, 7, 8, 10, 11 and 22-26 without prejudice. Claims 1-4, 6, 9, 12-21 and 27-32 remain pending. Claims 1, 15, 21, 27-29 and 32 are the pending independent claims.

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and the remarks below.

With regard to the §102(b) rejections over Thorpe and Steinberg, independent claims 1, 15, 27 and 28 have been amended in a manner which is believed to clearly overcome these rejections.

Independent claim 29 is directed to a digital still camera that includes a white balance determination processing unit determining white balance correction values from captured images, a memory storing a plurality of the white balance correction values, a selector choosing one of the plurality of white balance correction values, and a white balance correction processing unit applying a selected one of the white balance correction values to a plurality of captured images producing white balance corrected images. Neither Thorpe nor Steinberg discloses or suggests the claimed selectability among multiple stored white balance correction values in a digital still camera. The portions of the Thorpe and Steinberg references relied on by the

Examiner in rejecting claim 29 make no mention whatsoever regarding selectability among multiple white balance correction values stored in a digital still camera. The §102(b) rejections of independent claim 29 are therefore believed to be improper and should be withdrawn.

Independent claim 32 is directed to a digital still camera comprising a sensor capturing images, a lens for imaging light onto the sensor, a memory storing a plurality of white balance correction values, a selector operable by a user in choosing one of the plurality of white balance correction values, and a white balance correction processing unit applying a selected one of the white balance correction values to a plurality of captured images producing white balance corrected images. Again, neither Thorpe nor Steinberg discloses or suggests the claimed selectability among multiple stored white balance correction values in a digital still camera. The portions of the Thorpe and Steinberg references relied on by the Examiner in rejecting claim 32 make no mention whatsoever regarding selectability among multiple white balance correction values stored in a digital still camera. The §102(b) rejections of independent claim 32 are therefore believed to be improper and should be withdrawn.

With regard to the §103(a) rejection of independent claim 21 over Steinberg in view of Thorpe, Applicant notes that this claim is directed to a process which includes determining, in a digital camera, image processing settings for picture taking venues during initial visits to the venues using a reference card placed in a scene at the venues, assigning file name identifiers to the settings, saving the settings in a removable, non-volatile memory using the file name identifiers, and correcting pictures taken at the venues in subsequent visits to the venues, in the digital camera, with the saved settings contemporaneous with taking of the pictures at the venue. The claim further specifies that at least one of the settings comprises an image white balance setting, an image sharpness setting, a contrast setting and a colorfulness setting. Applicant submits that the collective teachings of Steinberg and Thorpe, if assumed to be combinable, fail to meet each and every limitation of the claim. For example, there is no disclosure in the collective teachings of Steinberg and Thorpe regarding the determination of image processing settings at venues using a reference card placed in a scene at the venues, the assignment of file name identifiers to the determined image

processing settings, or the particular setting comprising an image white balance setting, an image sharpness setting, a contrast setting and a colorfulness setting.

As to motivation to combine Steinberg and Thorpe, the Examiner at page 13, second paragraph, of the Office Action argues that the combination would be obvious “because it is well known in the art that parameters and settings can be determined in the digital camera or from an external device.”

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. There has been no showing in the §103(a) rejection of objective evidence of record that would motivate one skilled in the art to combine Steinberg and Thorpe to produce the particular limitations in question. Instead, the proposed combination appears to be based on a piecemeal reconstruction of the claimed invention, with the benefit of hindsight, rather than on any objective evidence of motivation. The statement of motivation provided by the Examiner at page 13, second paragraph, of the Office Action is a subjective and conclusory statement of obviousness, and insufficient to support the proposed combination of the reference teachings. Accordingly, the §103(a) rejection of independent claim 21 is believed to be improper and should be withdrawn.

The D’Luna reference fails to supplement the fundamental deficiencies of the Steinberg and Thorpe references as applied to the independent claims.

The dependent claims are believed allowable for at least the reasons identified above with regard to their respective independent claims.

It is believed that the claims in the application are allowable over the prior art and such allowance is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Eastman Kodak Company Deposit Account No. 05-0225.

A duplicate copy of this communication is enclosed.

Respectfully submitted,

A handwritten signature in cursive script, reading "Pamela R. Crocker", written over a horizontal line.

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Enclosures: Replacement Drawing Sheets (2)